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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,582	12/22/1999	STEVEN B. SOLOMON	067251.0105	6338
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BAKER & BOTTS 2001 ROSS AVENUE DALLAS, TX 75201				
			EXAMINER MYHRE, JAMES W	
			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/470,582

Applicant(s)

SOLOMON ET AL.

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-14, 16-26, 28-32, 34-38 and 40-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-14, 16-26, 28-32, 34-38, and 40-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on January 5, 2004 under 37 C.F.R. 1.111 has been considered but is ineffective to overcome the rejection of claims 1, 2, 4-14, 16-26, 28-32, and 34-38 based upon Finsterwald (6,039,244) and Freeman et al (6,450,407) as set forth in the last Office action. The amendment amended the dependency of Claim 11 and added new Claims 40-46. The currently pending claims considered below are Claims 1, 2, 4-14, 16-26, 28-32, 34-38, and 40-46.

### ***Claim Objections***

2. Claim 34 is objected to because of the following informalities: This claim is dependent upon Claim 33, which has been previously cancelled. The Examiner believes that this is a typographical error and that Claim 34 should depend upon Claim 32. The claim will be considered as depending on Claim 32 in the below office action. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-14, 16-26, 28-32, 34-38, and 40-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finsterwald (6,039,244) in view of Freeman et al (6,450,407).

Claims 1, 8, 9, 12, 20, 21, 24, 32, 36, 40, and 43: Finsterwald discloses a system, apparatus, and method for processing rebates, comprising:

- a. A promotion database describing various rebate offers received from sponsors (col 2, lines 46-65 and col 3, lines 57-62);
- b. A transaction database describing purchases made by customers of one or more merchants (col 2, lines 46-65 and col 3, lines 57-62);
- c. Receiving rebate a rebate request from a customer, the request including at least the customer's identity, the identity of the product for which the rebate is requested, and the identity of the corresponding transaction (e.g. customer name and address/account number, the UPC code for the rebated product, and the transaction/receipt number of the corresponding purchase)(col 2, lines 46-65; col 8, lines 19-21; and col 8, line 54 - col 9, line 44); and
- d. Providing a status report of a rebate to the customer (col 10, lines 21-25).

However, Finsterwald does not explicitly disclose generating promotion reports for the sponsors. Freeman discloses a similar system, apparatus, and method for processing rebates and further discloses generating promotion reports for the sponsors (11, lines 16-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to generate promotion reports for the sponsors in Finsterwald. One would have been motivated to generate such reports for the sponsors in view of Finsterwald's disclosure that maintaining demographic and transaction histories for the customers and for generating targeted messages based on such an information. Generating reports for the sponsors of these promotional programs would enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better.

Claims 2, 16, 28, 41, and 42: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, 20, and 40 above, and Finsterwald further discloses a plurality of rebate payment options available to the customer (col 2, lines 25-33 and col 6, lines 28-31).

Claims 4, 11, and 23: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, and 21 above. Finsterwald further discloses that it is customary "to send data or addresses via the postal route" (col 2, lines 8-10). Likewise Freeman also discloses allowing the customer to mail in the request form (col 3, lines 53-59). While Finsterwald discusses the advantages of not having to send the data via the postal route, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the customer in

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Finsterwald to mail in the rebate form instead of submitting it over a communication line such as the Internet or telephone system. One would have been motivated to allow the customer to mail in the rebate form in order to give the customer one more (well known) way to submit the data, especially if the customer is away from home (e.g. on vacation) and does not have access to an Internet connection nor telephone line (e.g. in a foreign country).

Claims 5, 13, 25, and 38: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, 24, and 32 above, and Freeman further discloses the promotion reports includes all pertinent information about the rebate program, such as number of rebates, breakage rate, name and addresses of requestors, etc. (col 11, lines 16-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to generate promotion reports including the above information to the sponsors in Finsterwald. One would have been motivate to generate such reports for the sponsors in view of Finsterwald's disclosure that maintaining demographic and transaction histories for the customers and for generating targeted messages based on such an information. Generating reports for the sponsors of these promotional programs would enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better.

Claim 6: Finsterwald and Freeman disclose a system for processing rebates as in Claim 1 above, and Finsterwald further discloses the customer receiving a status report on a submitted rebate request (col 10, lines 21-25).

Claims 7, 14, and 26: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, and 20 above, and Finsterwald further discloses receiving verification/approval of the rebate request and that the disbursement of the rebate may take several forms. However, neither reference explicitly discloses receiving the selection of the rebate disbursement type from the customer. Official Notice is taken that it is old and well known to solicit a selection of a disbursement method from the receiver. For example, lottery winners are asked to select between at least two disbursement methods: lump sum of cash, or an annuity. Likewise, taxpayers due a refund are asked to select either a direct deposit of the refund to a financial account or to receive a physical refund check through the postal mail. Finally, customer due a refund when returning a purchased item to a store are often given the choice of a cash rebate or a credit to their store credit account. Therefore, it would have been obvious to one having ordinary skill in the art to allow the customer in Finsterwald to select the desired disbursement method from among the several types of rebates disclosed by Finsterwald. One would have been motivated to allow the customer to select the disbursement method in order to provide greater customer service thereby increasing customer satisfaction with the system.

Claims 10, 22, and 37: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 9, 21, and 36 above, and Finsterwald further discloses receiving the information over a network, such as the Internet (col 8, line 19 - col 9, line 44).

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Claims 17, 29, and 34: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 16, 28, and 33 above, and Finsterwald further discloses various disbursement options comprise a cash rebate and a credit voucher ("e-cash" and "rights of use of specific Internet services", i.e. a credit voucher for the Internet services)(col 2. Lines 25-33 and col 6, lines 28-31).

Claims 18, 30, 35, and 44: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 16, 20, and 32 above, and Freeman further discloses the promotion including a product identifier, an end date for the promotion, and a geographic target for the promotion (col 10, line 48 - col 11, line 15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such information in the promotion within Finsterwald. One would have been motivated to include the product identifier, an end date for the promotion, and a geographic target for the promotion in view of Finsterwald's disclosure of storing similar types of data, such as "the nature of the product or of the service, to the place of production or the point of sale, to the time of production or the time of sale and/or the price of the product or of the service" (col 3, lines 3-6) and customer-specific data such as "the name, the postal address, the telephone number, the age, the sex and/or the profession of the customer" (col 5, lines 12-16) and for using such data for targeted advertising which is selected based on the stored data (col 6, lines 46-48).



Claims 19 and 31: Finsterwald and Freeman disclose a method and apparatus for processing rebates as in Claims 8 and 20 above, and both references further disclose the transaction information including personal information of the purchaser and the purchase information (Finsterwald, col 2, lines 46-61 and col 4, lines 30-42)(Freeman, col 20, lines 53-59).

Claim 45: Finsterwald and Freeman disclose an apparatus for processing rebates as in Claim 43 above, and Finsterwald explicitly discloses that the promotion requirements include a proof of purchase ("the code handed out with the product or with the service serves to show that the customer has actually purchased the relevant product or the relevant service", i.e. a proof of purchase)(col 2, lines 46-49).

Claim 46: Finsterwald and Freeman disclose an apparatus for processing rebates as in Claim 43 above, and Finsterwald further discloses that the promotion requirements include a rebate request form including the rebate transaction identifier (col 1, lines 42-65 and col 7, lines 56-60). While Finsterwald does not use the word "form" to describe the submission by the customer when requesting a rebate, it is disclosed that the customer provides the code and characteristic data about the customer to the data collection point via the internet. A common way to submit information over the Internet is to use HTML forms. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an HTML form when the customer in Finsterwald submits the required rebate information. One would have been motivated to use a form in order to guide the customer, thus ensuring receipt of the required information.

***Response to Arguments***

5. Applicant's arguments filed January 5, 2004 have been fully considered but they are not persuasive.

The Applicant argues that Finsterwald does not disclose providing rebate status updates to the customer (page 13). The Examiner notes that, as the Applicant discussed, Finsterwald discloses that the customer can request status information about his account. It is also disclosed that the Finsterwald system not only maintains a database of pending rebates along with their rebate codes, but also maintains information about which rebate codes have been used so as to prevent a customer from claiming the same rebate more than one time. Thus, the system is changing the status of the rebate (and rebate code) from pending (issued) to redeemed (used). Since this information is stored in the same system which maintains the customer's account status information and since the customer has access to this status information, it is inherent that the customer can be provided with access to any of the information stored in the system. Granting such access to the information is a design decision by the system operators who may set any limits or no limits on access to the databases. Per Applicant's argument that since Finsterwald immediately credits the rebate amount to the customer upon processing the rebate request there is no need to store a rebate status code, the Examiner notes that since the Applicant's invention also uses a computer system to automatically process the rebates, it too would only maintain a rebate status for a few milliseconds, at most, while the processor completed the rebate transaction. Like Finsterwald the Applicant's invention could maintain a status of "paid"

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once the rebate had been processed. As discussed above, Finsterwald does disclose maintaining a database of pending and redeemed rebate codes, thus disclosing at least two status states for the rebate.

The Applicant argues that Finsterwald does not disclose generating promotion reports for sponsors (pages 13-14). The Examiner notes that Finsterwald discloses using the collected data for such purposes as determining "the amount of time which elapses between the manufacture and the sale of the product" (col 5, lines 28-30), targeting advertisements to the individual customer (col 6, lines 40-53), and that "This data can be utilized in the initially likewise described manner by the offeree of the products or services purchased by the customer 14, in particular for the adaptation of the respective marketing strategy or for the transmission of advertising messages" (col 10, lines 5-9). Thus, it is implied that the collected data is being sent (reported) to the sponsors of the targeted advertisements and/or manufacturers.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references pertain to process rebates on purchased products or services, both references further disclose tracking and storing data pertaining to the customer and the rebate. Therefore,

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it would have been obvious to one attempting to set up a rebate processing system to select one or more features from one reference to combine with features from the other reference. The Applicant argues that Finsterwald would have no motivation to maintain records for potential audits as disclosed by Freeman. However, the Examiner notes that depending upon the laws of local jurisdiction where the Finsterwald system resides the system operator may not only be motivated to maintain financial records, but required to do so by law. Even without such a legal requirement for maintaining financial records, it would have been obvious to keep such records for a wide variety of purposes, such as audits, tax filings, profitability determination, etc....all normal activities undertaken by businesses, thus rendering the combination of Finsterwald and Freeman very obvious.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM

February 9, 2004



James W. Myhre  
Primary Examiner  
Art Unit 3622